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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KYMSTA CORP.,
a California corporation,

Petitioner,

vs.

QUIKSILVER, INC.,
a Delaware corporation,

Respondent

CANCELLATION NO. 92041805

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

April 9, 2004

Date

James D. Nguyen
JAMES D. NGUYEN

**KYMSTA CORP.'S SURREPLY OPPOSING QUIKSILVER'S REQUEST FOR DECISION
BASED ON RELATED CIVIL ACTION**

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ATT: BOX TTAB NO FEE



04-12-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Petitioner Kymsta Corp. ("Kymsta") submits this surreply in opposition to Quiksilver, Inc.'s request for a decision based the related civil action. Normally, Kymsta would not submit a surreply but one is needed to correct Quiksilver's mischaracterization of Kymsta's docket statement in the related civil appeal.

Quiksilver incorrectly claims that Kymsta did not appeal the district court's finding that Quiksilver is the senior user and owner of certain ROXY marks. That is incorrect; Kymsta certainly intends to challenge that portion of the district court's judgment. On its Civil Appeals Docketing Statement (Exhibit 1 to Quiksilver's reply),

Kymsta listed a principal issue for appeal as: “Whether the trial court incorrectly found that ‘tacking’ doctrine applicable so that Quiksilver’s ROXY mark for clothing was **entitled to the same first use date (for trademark priority purposes)** as Quiksilver’s QUIKSILVER ROXY mark for clothing.” (Emphasis added). Kymsta concedes that Quiksilver used the QUIKSILVER ROXY mark (in 1990 or 1991) before Kymsta used ROXYWEAR (in January 1992); however, Kymsta contends that ROXY came later in time than ROXYWEAR, and that ROXY is not entitled to the benefit of the tacking doctrine to enjoy the same first use date as QUIKSILVER ROXY. If, as Kymsta contends in the civil appeal, the tacking doctrine does not apply to ROXY, Kymsta’s ROXYWEAR mark has priority over Quiksilver’s ROXY mark and Kymsta (not Quiksilver) is the senior user. Thus, the tacking/first use/priority decision directly impacts whether Quiksilver is the “senior user” of the ROXY mark on clothing. That is obviously the purpose behind Kymsta listing the tacking/first use/priority issue as one item for appeal.

Furthermore, as previously explained in Kymsta’s opposition brief, Kymsta is in fact challenging the district court’s finding that Quiksilver’s trademark registration no. 2,427,898 (the subject of this cancellation proceeding) is “valid and protectable”. That is clearly listed on Kymsta’s docketing statement (principal issues #3). Kymsta will argue that the district court incorrectly found Quiksilver’s registration to be valid and protectable because Kymsta has senior rights to its ROXYWEAR mark. Thus, the appeal will undisputedly and directly affect the issues in this cancellation proceeding.

Quiksilver is improperly trying to pre-determine the appeal issues from Kymsta’s Civil Appeals Docketing Statement, treating the docketing statement as if it represents the full and final statement of appellate issues. That form only required Kymsta to list “principal issues proposed to be raised on appeal” and is merely intended to provide basic information about the case. On its face, the form is not meant to require an exhaustive list of appeal issues. Kymsta itself noted on its statement that “This is not an exhaustive

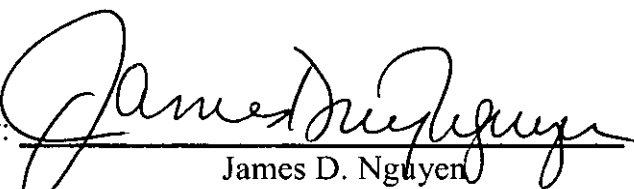
list of all issues that Kymsta will raise on appeal . . .” (See Ex. 1 to Quiksilver reply). Kymsta is not required to identify all appellate issues until its opening brief. (See Fed. R. App. Proc. 28(a)(9)(appellant’s brief must contain contentions and reasons for them).)

In reality, Quiksilver is trying to circumvent Kymsta’s rights in this proceeding while the civil appeal is pending. That should not be permitted, and in the interests of justice, this cancellation proceeding should remain stayed pending Kymsta’s appeal and final disposition of the related civil action.

DATED: April 9, 2004

Respectfully submitted,

KYMSTA CORP.

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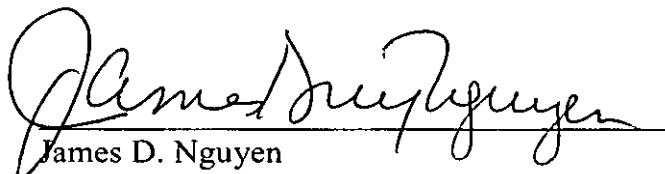
Facsimile: (310) 557-8475

Attorneys for Petitioner **KYMSTA CORP.**

CERTIFICATE OF SERVICE

I hereby certify that this **Kymsta Corp.'s Surreply in Opposition to Quiksilver's Request for Decision Based on Related Civil Action** and all marked attachments have been served upon the attorney for the trademark owner and respondent, Quiksilver, Inc., on April 9, 2004, by depositing same in the United States mail, first class postage prepaid, in an envelope addressed as follows:

Jeffrey L. Van Hoosear, Esq.
KNOBBE, MARTENS, OLSON & BAER, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

A handwritten signature in black ink, appearing to read "James D. Nguyen", written over a horizontal line.

James D. Nguyen
Date of Signature: April 9, 2004